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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,142	07/25/2003	Ignatius Xavier Haase	02-10635	9437
36212 7590 05/01/2007 LAW OFFICES OF DAVID L. HOFFMAN 27023 MCBEAN PKWY SUITE 422 VALENCIA, CA 91355			EXAMINER BLACKWELL, JAMES H	
			ART UNIT 2176	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/628,142

Applicant(s)

HAASE, IGNATIUS XAVIER

Examiner

James H. Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to an Amendment filed 01/29/2007 with a priority date of **08/02/2002**.
2. Claims 1-20 remain pending. Claims 1, 7, and 13 are independent claims.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al. (hereinafter Rivette, U.S. Patent No. 5,623,679 filed 04/18/1995, issued 04/22/1997).

**In regard to independent Claim 1, Rivette discloses:**

- *A method of encoding a document* (Title; Col. 4, lines 17-19; → ... creating an manipulating notes each containing multiple sub-notes, and linking the sub-notes to portions of data objects that are highlighted by the user), *comprising the steps of:*
  - *identifying multiple characteristics about text of the document* (Fig. 37; Col. 36, line 40 through Col. 37, line 21; → a user can choose to annotate portions of a document (words, sentences, paragraphs, etc.) by

highlighting those portions using a marker of a desired color by, for example, “clicking” and “dragging” a mouse to highlight the portion. The highlighting also creates a “color indicator” (542) in the margin with the same color as that of the highlight). The user, in highlighting text in this manner is interpreted to have *identified a characteristic about text of the document*, as claimed. In addition, the “color indicator” is further identified with a shape (square, triangle, circle). Further, it is possible to overlap highlights made on the same portion of text (Col. 37, lines 13-21) creating multiple “color indicators” in the margin adjacent to the highlighted text. Thus, the user can *identify multiple characteristics about text of the document* in this way.

- o *creating a key for correlating the multiple characteristics with multiple unique indicia* (Figs. 11, 56, 62; Col. 41, lines 1-26; → selection of a patent note icon downward arrow (127, Fig. 11) results in the display of a menu (902) in Fig. 62 listing all patent notes which have been sorted according to the specifications in the preferences dialog box 770 in Fig. 56. As shown, the patent notes include various symbol icons in appropriate colors as well as a numerical indicator of the patent note number.) This pull-down menu is interpreted a *key or legend* to the “color indicators” in the margins. As the user highlights more text, more entries are added to this pull-down menu. Thus, the key or legend is “created” and added to in the process of adding new highlights (and subsequently more notes).

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- *placing at least some of the unique indicia adjacent at least some lines of text in the document* (see Fig. 37, items 540, 542; → highlight and corresponding “color indicator” in margin adjacent to the highlighted text), *wherein*
  - *the unique indicia placed adjacent each line of text correspond to the characteristic or characteristics in the line of text on the basis of the key* (see Fig. 37, items 540, 542; Col. 37, lines 13-21; → highlight and corresponding “color indicator” in margin adjacent to the highlighted text, and multiple, overlapping highlights and “color indicators” created), and

wherein

- *there is at least one line of text having at least two unique indicia adjacent thereto* (Col. 37, lines 13-21) creating multiple “color indicators” in the margin adjacent to the highlighted text).

**In regard to dependent Claim 2, Rivette discloses:**

- *in the steps of creating and placing the unique indicia comprise color-coded segments* (Col. 36, line 40 through Col. 37, line 21; → highlighting text produces a corresponding shaped, colored coded (Col. 36, lines 61-63) “color indicator” in the margin adjacent to the text that was highlighted). A segment is interpreted as a single item such as a single “color indicator”.

**In regard to dependent Claim 3, Rivette discloses:**

- *the document is stored on a digital medium* (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1; → equivalent files and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)), *and*
- *in the steps of creating and placing,*
  - *the key is stored on a digital medium* (Fig. 61, item 127; Col. 42, lines 39-63; → pull-down menu shows notes with corresponding indicia (shape icons and colors) that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). As the user adds highlighting and notes, the GUI keeps track (and likely stores) this information.
  - *the unique indicia are stored in a digital medium* (Col. 42, line 35, 39-63; → indicia are stored with notes/sub-notes which are stored in a database).

**In regard to dependent Claim 4, Rivette discloses:**

- *in the steps of creating and placing*
  - *the color-encoded segments are placed in a margin adjacent to and in line with the text of the line* (Figs. 37, 63, window labeled 160; → "color indicators" are seen in a margin adjacent to and in line with the text of the line), *and*

*wherein*

- *there are at least some color-coded segments placed contiguously with the same color-coded segments from adjacent lines of text and in a columnar arrangement perpendicular to the lines of text (Fig. 63, window labeled 160; → displayed triangles (two) of the same color (actually lack of color in the Figure) placed contiguously and in a column).*

**In regard to dependent Claim 5, Rivette discloses:**

- *selectively changing the key by changing at least one of the color-coding and the characteristics (Fig. 61, item 127; Col. 42, lines 39-63; → pull-down menu shows notes with corresponding indicia ("color indicators") that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). It is clear that if the user adds, removes, or makes other changes to the notes, that the pull-down menu (key) would be altered to reflect the current state of the number, and type (color, shape) of notes present in the content).*

**In regard to dependent Claim 6, Rivette discloses:**

- *the step of placing comprises*
  - *printing the document with the unique indicia adjacent to the line of text in a margin thereof (Figs. 3, 41, 51; Col. 39 lines 3548; → the selection of the Print command from menu 570 of Fig. 41 results in the display of a Print dialog box 750, as shown in Fig. 51. The Print dialog box permits the*

printing of various files, including but not limited to, patent images, case and patent notes and Equivalent Files on a printer 57 in Fig. 3 or to a file).

The text files are a component of the Equivalent files and contain the "color indicators" and thus would be printed along with the rest of the document.

**In regard to dependent Claim 8, Rivette discloses:**

- *the memory comprises a digital recording medium ( see Fig. 1, items 25, 28);*
- *processor (see Fig. 1, items 8, 13, 20, 27);*
- *selectively changing the key by changing at least one of the color-coding and the characteristics (Fig. 61, item 127; Col. 42, lines 39-63;→ pull-down menu shows notes with corresponding indicia ("color indicators") that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). It is clear that if the user adds, removes, or makes other changes to the notes, that the pull-down menu (key) would be altered to reflect the current state of the number, and type (color, shape) of notes present in the content).*

**In regard to Claims 7, 9 and 10, Claims 7, 9 and 10 merely recite a system for performing the method of Claims 1, 2, and 4, respectively. Thus, Rivette discloses every limitation of Claims 7, 9 and 10, as indicated in the above rejection for Claims 1, 2 and 4.**



**In regard to dependent Claim 11, Rivette discloses:**

- *the display comprises a computer monitor (see Fig. 3; Abstract; → patent contents are displayed on a screen for manipulation and annotation).*

**In regard to dependent Claim 12, Rivette discloses:**

- *the unique indicia are displayed in columns formed in the margin of the document, and at least some lines have at least two characteristics and a corresponding number of unique indicia in the margin adjacent the lines (e.g., Fig. 63; Col. 36, lines 13-21; → the figure shows unique indicia ("color indicators") in the right margin of window 160 in a columnar arrangement. It is further disclosed that it is possible to overlap marker colors over the same area of text. By overriding one marker with another, multiple patent notes for the same text may be created. If a given portion of text within window 160 has been highlighted, multiple color indicators (542) will be displayed in a horizontal row adjacent to one another. This feature would allow for multiple "color indicators" to appear for a given line adjacent to the text and with one another, and together with other "color indicators" on the page, form multiple columns of "color indicators" in the margin).*

**In regard to dependent Claim 16, Rivette discloses:**

- *wherein the unique indicia are displayed in a margin of the document in columns, and at least some lines of text have at least two characteristics and a corresponding number of unique indicia in the margin (e.g., Fig. 63; Col. 36, lines 13-21; → the figure show unique indicia ("color indicators") in the right margin of window 160, Col. 36 discloses that it is possible to overlap marker colors over the same area of text. By overriding one marker with another, multiple patent notes for the same text may be created. If a given portion of text within window 160 has been highlighted, multiple color indicators 542 will be displayed in a horizontal row adjacent to one another. This feature would allow for multiple note icons to appear for a given line adjacent to the text and with one another, and together with other "color indicators" on the page, form multiple columns of "color indicators" in the margin).*

**In regard to dependent Claim 17, Rivette discloses:**

- *the characteristics of each line are stored in a digital recording medium (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1; Rivette claims 1, 2; → equivalent files and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)).*
- *there is a step of selectively placing a plurality of the unique indicia corresponding to the multiple characteristics, based on the key, adjacent at least some of the lines of text (Fig. 37, items 540, 542; → upon highlighting text (540),*

a "color indicator" (542) is created in the margin of the document. Col. 36, lines 13-21 provide for multiple "color indicators" being placed adjacent to the line of text and to one another).

**In regard to dependent Claim 18, Rivette discloses:**

- *a controller for enabling a user to select a plurality of the multiple characteristics, and for changing the display based on the selection to show the unique indicia, which correspond to the selected multiple characteristics* (Col. 41, lines 1-26; Figs. 60-63; → a graphical user interface that allows the user to create, manipulate, delete and otherwise alter notes and sub notes).

**In regard to dependent Claim 19, Rivette discloses:**

- *the document is stored on a digital medium* (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1; Rivette claims 1, 2; → equivalent files and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)).

**In regard to dependent Claim 20, Rivette discloses:**

- *storing the document on the digital recording medium* (see Rivette claims 1, 2; → means for storing patent document components and notes (and hence "color indicators" on media).

**In regard to Claims 13, 14 and 15**, Claims 13, 14 and 15 merely recite an encoded document to perform the method of Claims 1, 2 and 4 upon, respectfully. Thus, Rivette discloses every limitation of Claims 13, 14 and 15, as indicated in the above rejection for Claims 1, 2 and 4.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

6. However, the Examiner respectfully disagrees with the Applicant on the following point: that *the prior art of Hernandez uses text phrases to explain symbols rather than symbols to explain text* (Pg. 11 of Applicant's remarks).

Hernandez provides single character labels (symbols) in a margin of a document displayed on a screen to indicate the location of different types of content in the document. The different content can be text, graphics, charts, etc. The point is that these margin symbols indicate the various document components in a block-like fashion. So there exist text blocks, graphic blocks, chart blocks, etc. The Examiner would interpret these various blocks and their corresponding symbol indicators as describing characteristics of the whole of the document (i.e., the document consists of blocks of text, graphics, charts, etc.).

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James H. Blackwell  
04/26/2007

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

**Doug Hutton**  
**Primary Examiner**  
**Technology Center 2100**